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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/814,253

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Julio A. Abusleme

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12/30/2005

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EXAMINER

ZEMEL, IRINA SOPJIA

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/814,253

Applicant(s)

ABUSLEME ET AL.

Examiner

Irina S. Zemel

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 10-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 and 10-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 it is not apparent whether the limitation "wherein said foamable compositions do not contain any other foaming agents" limits the foaming agent to the component B, or this negative limitation excludes any additional foaming agents except for those that make the composition foamable.

Claim 12 claims coatings in the plural while the base claim 11 claims "coating".

Claim 13 is nor further limiting of claim 12 since it claims only a foamed coating, while the base claim 12 claims "articles and foamed coatings" (not in the alternative).

Claims 23 and 24 claim an composition, while being dependent on the article base claim 12.

### ***Allowable Subject Matter***

Claims 1-8 and 10-24 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

The allowability is indicated with the assumption that the base claim 1 is limited to only one blowing agent which is component B.

***Response to Arguments***

Applicant's arguments, filed 10-7-2005, with respect to all pending have been fully considered and are persuasive. The art rejection of the claims have been withdrawn.

The examiner, however wishes to point out that she strongly disagrees with the applicants' assertion that the base reference, Mehan, does not 'expressly teaches foaming without additional foaming agents. As discussed in the previous office action, and as quoted by the applicants themselves, the reference expressly stated that "generally, the presence of the fine prticles of PTFE will result in some degree of foamingq, even when no positive steps are taken to cause the foaming. Preferably, positive steps are taken to foam the composition as it is melt-extruded, using a foaming anent which is incorporated in the composition and decomposes into a gas as the composition is extruded..." Thus, the reference expressly discloses foamable compositions that do not contain any additional foaming agents, even though, those embodiments may not be the preferred embodiments. Also, note that there is NO degree of foaming claimed in the instant claims, and, all that is required that the compositions are "foamable", which is clearly met by the disclosure of the reference cited above, i.e., "the presence of the fine particles of PTFE will result in some degree of foamingq, even when no positive steps are taken to cause the foaming".

However, with assumption that the claims are limited to the presence of the only blowing/nucleating agent, i.e., the claimed component B, the base reference does not teach the use of the chlorotrifluoroethylene (CTFE) homo- or copolymer which contains high (above 80) mole % of the CTFE units with comonomers limited to the two claimed comonomers. While CTFE homopolymers are notoriously known in the art, and the claimed copolymers are also known in the art (see, for example, 6,277,936) there is no motivation to substitute the Ethylene-CTFE copolymers of Mehan with high content of ethylene with the claimed CTFE homo- or copolymers with reasonable expectation to obtain compositions that are 1) foamable compositions and 2) exhibit properties desired for the invention of Mehan since the properties and applications of the high content ethylene E-CTFE copolymers such as those needed for the invention of Mehan are not comparable to the properties of the claimed CTFE homo-copolymers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Irina S. Zemel  
Examiner  
Art Unit 1711

ISZ

A handwritten signature in black ink, appearing to read "Irina Zemel", is positioned below the printed name and title.